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No. 93-862

IN THE
Supreme Court of the United States
OCTOBER TERM, 1993

BELLSOUTH ADVERTISING & PUBLISHING CORPORATION,
Petitioner,
v.
DONNELLEY INFORMATION PUBLISHING, INC. and THE REUBEN H. DONNELLEY CORPORATION,
Respondents.

On Petition for a Writ of Certiorari to the United States Court of Appeals for the Eleventh Circuit

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REPLY BRIEF FOR PETITIONER

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REPLY BRIEF FOR PETITIONER [1]

Respondent Donnelley Information Publishing, Inc. ("Donnelley") seeks to avoid certiorari by rewriting and downplaying the significance of a divided en banc decision recognized by the dissent, the classified directory industry, and the data compilation industry as a whole to be a ruling with dramatic nationwide impact.[2] Don-

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[1] Petitioner's Rule 29.1 statement appears at Pet. App. 115a.

[2] *See* Pet. App. 19a ("The majority's holding establishes a rule of law that transforms the multi-billion dollar classified publishing industry") (Hatchett, J., dissenting); Brief of Amici Curiae Ameritech Publishing, Inc., NYNEX Corporation, and Bell Atlantic Corporation in Support of Petitioner at 4, 11-13; Brief of Amicus Curiae United States Telephone Association in Support of Petitioner at 4-6; Brief Amicus Curiae of Sprint Publishing & Adver-

nelley's efforts simply confirm the need for this Court to grant the writ to resolve the conflict and confusion in the lower courts.

1. Donnelley's main effort to rewrite the decision below is its startling assertion that this case "presents no issue about copyrightability of yellow pages directories or any other type of fact compilation." Opp. at 12-13. Donnelley pins a great deal on this claim, repeating it no fewer than eight times (Opp. at 2, 8, 9, 10, 12-13, 20, 22, 25), and attempting to distinguish conflicting authority on this ground. *See, e.g.*, Opp. at 20, 22.

But Donnelley's assertion is simply a word game. Donnelley did concede copyrightability, but the whole issue is the extent of the protection conferred by the copyright. The Eleventh Circuit below held that BAPCO's copyright did not protect BAPCO's acts of selection, coordination, and arrangement in compiling its directory; the results of those acts of authorship were held to be not copyrightable.

Donnelley's concession that BAPCO has a valid copyright in other aspects of the yellow pages—the graphics or artwork, for example—in no way affects the key holding below that the compilation aspects of the work are not copyrightable. The holding is the same whether phrased in terms of BAPCO owning a copyright that does not protect the selection, coordination, and arrangement of its yellow pages (as Donnelley would prefer) or in terms of BAPCO's selection, coordination, and arrangement of its yellow pages not being copyrightable.[3]

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tising, Inc. in Support of Petitioner at 3; Brief of West Publishing Company as Amicus Curiae in Support of Petition for Writ of Certiorari at 3-4; Brief of Martindale-Hubbell, Inc. as Amicus Curiae in Support of Petitioner. The various briefs amicus curiae have been filed with motions for leave to file, necessitated by Donnelley's refusal to consent to their filing.

[3] Donnelley cannot even maintain its own word game throughout its Opposition. *See, e.g.*, Opp. at 14 ("the Eleventh Circuit held

That is why other courts have recognized that this case concerns the copyrightability of yellow pages directories. *See, e.g., Atari Games Corp.* v. *Oman*, 979 F.2d 242, 246 (D.C. Cir. 1992) (panel holding here *and* in *Key Publications* described as "yellow page telephone directory is copyrightable").

2. On the merits, Donnelley's position turns on two related propositions: (1) this case is like *Feist* because Donnelley copied only facts (Opp. at 13), and (2) BAPCO and the panel below erred in focusing on "whether BAPCO's directory as a whole was copyrightable." *Id.* at 8. The issue is fairly joined on both points.

a. The error of the en banc majority below, and the reason the decision is so problematic not only for the business directory industry but for the compilation industry generally, is precisely that the Eleventh Circuit agreed with Donnelley and regarded this case as just like *Feist*. It is not. *Feist* involved purely factual material—name, address, telephone number—selected and arranged in what this Court termed a practically inevitable manner involving no creativity. Individual names, addresses, and telephone numbers are not at issue here; BAPCO claims no copyright in such factual material. What is at issue—and what makes this case quite unlike *Feist*—are the results of BAPCO's creativity in selecting, coordinating, and arranging listings and headings in its directory.

It is not a "fact" that a business should be listed as a barber rather than or in addition to being listed as a hair stylist. It is not a "fact" that there should be four subheadings under "Appliances" rather than six, two, or none at all. It is not a "fact" that 1,772 selected businesses outside the area of the Miami directory should nonetheless be included in it. It is not a "fact" that those offering balloon bouquets should not be listed under

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that * * * constituent elements were unoriginal to BAPCO and therefore *uncopyrightable*") (emphasis added).

"Florists" as they want to be, or that a business using only residential telephone service should not be included at all.

These and the myriad other decisions about selection, coordination, and arrangement detailed in the Petition, *see* Pet. at 3-7, 17-21—none of which were involved in *Feist*—are what make BAPCO's directory protectible as a compilation. Donnelley did not simply copy facts—it copied the results of BAPCO's creativity. Perhaps the clearest example is the 1,772 businesses outside the Miami area selected for inclusion in the Miami directory by BAPCO. Because it simply copied BAPCO's directory, Donnelley also included those businesses in its database. There is no objective, factual reason for such inclusion; Donnelley simply copied BAPCO's selection. *See also* Pet. at 19 n.9 (Donnelley's claim that it copied only "facts" is refuted by its copying of erroneous listings).

b. The issue is also fairly joined on the question whether the directory should be considered "as a whole" in assessing compilation copyright protection. Donnelley, dismissing such an approach as a "*gestalt* theory," contends that the panel erred in focusing on "whether BAPCO's directory as a whole was copyrightable." Opp. at 8. Not to put too fine a point on it, that is *precisely* what the statute requires by its plain terms. Section 103(a) of the Copyright Act extends copyright protection to "compilations," and a "compilation" is defined in Section 101 as "a work formed by the collection and assembling of preexisting materials or of data that are selected, coordinated, or arranged in such a way that the resulting work *as a whole* constitutes an original work of authorship." 17 U.S.C. § 101 (emphasis added).

The reason is clear: data compilations are compilations of facts. If a court did not consider the work "as a whole," it would always find that the individual elements are facts, and there would be no copyright protection for such compilations, contrary to the express directive of Congress. Consideration of the work "as a whole" neces-

sitates consideration of the manner in which the constituent facts are selected, coordinated, or arranged—and it is the selection, coordination, or arrangement that is protected, rather than the underlying facts. The point is a critical one to the future of compilation copyright protection. The fact that Donnelley can so boldly read the decision below as rejecting consideration of BAPCO's compilation "as a whole"—as mandated by the Copyright Act itself—confirms the need for this Court's review.

Not surprisingly, Donnelley's position is at odds with the law in the Second Circuit. While Donnelley criticizes BAPCO and the panel below for evaluating " 'the compilation as a whole,' " Opp. at 29 (quoting Pet. at 11), the Second Circuit in *Key Publications* emphasized that the pertinent inquiry was indeed "whether the arrangement of the * * * Directory, *viewed in the aggregate*, is original." 945 F.2d at 514 (emphasis added). And while Donnelley argues that the various "content-defining acts" engaged in by BAPCO in compiling its directory cannot give rise to copyright protection under *Feist*, the United States District Court for the Southern District of New York made precisely the opposite point just last month, ruling that "originality, for copyright purposes, looks to creative process rather than novel outcomes or results." *Tempo Music, Inc.* v. *Famous Music Corp.*, 1993 U.S. Dist. LEXIS 17623, at *19 (S.D.N.Y. 1993).

Donnelley's contention that BAPCO is seeking to copyright facts is a red herring. Donnelley is of course perfectly free to do whatever it wishes with the name, address, and telephone number of any business in BAPCO's directory, and perfectly free in compiling its own directory to designate a particular enterprise a bakery even if BAPCO has already done so. What BAPCO is entitled to is compilation copyright protection for its directory "as a whole," 17 U.S.C. § 101, and what Donnelley may not do is copy BAPCO's compilation—the results of BAPCO's selection, coordination, and arrangement of the

thousands upon thousands of pieces of information that are all readily available to Donnelley in raw form. Donnelley did not use that information to create its own directory but instead copied BAPCO's directory precisely because Donnelley wanted the benefit of BAPCO's selection, coordination, and arrangement, even though the uncompiled information available to Donnelley was far more current.

3. On the issue of the specific headings—only one of the several aspects of selection, coordination, and arrangement that went into compiling BAPCO's directory—Donnelley maintains that it is immune from liability because, while it "admitted" that it "copied the * * * type of business from every BAPCO listing," Pet. App. 18a n.23 (en banc majority), it did not use precisely the same designation in every instance. *See* Opp. at 5, 10. The disingenuous nature of Donnelley's claim is demonstrated by examination of the classification of the seven businesses identified on the sales lead sheets (stipulated to be representative of those Donnelley generated from BAPCO's directory) that were attached to the Eleventh Circuit's decision as Exhibit B and lodged with the Clerk here. Those seven businesses generated listings under 40 different headings in BAPCO's directory and under an identical number of headings in Donnelley's directory. Of the 40 headings in Donnelley's directory, 37 were *identical* in wording to BAPCO's headings, including such details as the "Etc." in the listing for "Water Companies —Bottled, Bulk, Etc." The only differences were one of the nine headings for Bliss Van Den Heuvel, which BAPCO titled "Gold Leaf" and Donnelley reproduced as "Gold Leaf Lettering," and two of the 18 different headings for Starr Enterprises, entitled "Air Conditioning Equipment—Room Units" and "Television & Radio Dealers" by BAPCO and "Air Conditioning—Room Units" and "Television Dealers—Retail" by Donnelley. These slight differences plainly do not insulate Donnelley from liability for its admitted copying. *See* Pet. at 18 n.8.

4. Donnelley's effort to minimize the conflict between the decision below and the Second Circuit's decision in *Key Publications, Inc.* v. *Chinatown Today Publishing Enterprises, Inc.*, 945 F.2d 509 (2d Cir. 1991), begins with its word game that there was no issue of copyrightability in the decision below, as discussed above. *See* Opp. at 22. Donnelley next tries to distinguish *Key Publications* on the ground that it involved a directory for the Chinese-American community. But the Second Circuit was quite clear that its holding did not turn on that fact. Judge Winter explained that the decision of the publisher to exclude certain businesses from the directory because of their questionable longevity—the very reason BAPCO excluded certain businesses from its directory, *see* Pet. at 4—"*alone* indicates thought and creativity in the selection of businesses included in the * * * Directory." 945 F.2d at 513 (emphasis added). And while Donnelley tries to distinguish *Key Publications* by arguing that the particular classifications at issue there were "significant[]," Opp. at 21, the Second Circuit expressly stated that "the individual categories chosen are irrelevant to our inquiry." 945 F.2d at 514.

The conflict between the court below and the Second Circuit is clear from a comparison of the opinions. *Compare, e.g., Key Publications*, 945 F.2d at 514 (fact that "[t]he format of the * * * Directory is common to most classified directories, and particular categories have, of course, been used in other classified directories" not impediments to copyright protection) *with* App. 9a-10a & n.13 (copyright protection denied because "BAPCO did not deviate from the arrangement of the typical business directory"). The conflict is also confirmed by how other courts and commentators have viewed the decisions. The D.C. Circuit recognized that the holding in *Key Publications* was that "yellow page telephone directory is copyrightable"—the same description it applied to the panel decision in this case, which was reversed by the en banc court. *Atari Games Corp.* v. *Oman*, 979 F.2d at 246.

And when the leading treatise on copyright law, *Nimmer on Copyright*, concluded that *Feist* "does not bar copyright protection for telephone book yellow pages," it relied on both the panel decision below and *Key Publications*. 1 *Nimmer on Copyright*, § 3.04[B] at 3-28–3-29 & n.53 (1993).

5. Donnelley's effort to portray the legal issue in this case as fact-specific is unavailing. Donnelley focuses on its particular method of copying BAPCO's directory, Opp. at 9, but the record confirms not only that Donnelley engaged in this method with respect to hundreds of other copyrighted directories, but also that the method is widely prevalent throughout the industry. *See* Affidavit of Gary R. Johnson, ¶ 11. By the same token, BAPCO's processes for compiling its directory are also typical throughout the industry, at least for those who do not copy the selection, coordination, and arrangement of others. *See* Brief of Amici Curiae Ameritech Publishing, Inc., NYNEX Corporation, and Bell Atlantic Corporation in Support of Petitioner, at 4-11 (describing industry-wide practice). The decision below was in no sense fact-specific, but instead "establish[ed] a rule of law" governing the entire classified publishing industry. Pet. App. 19a (Hatchett, J., dissenting). *See also* Pet. App. 15a (BAPCO's selection, coordination, and arrangement not entitled to copyright protection "as a matter of law").

Donnelley's contention that there is no confusion in the lower courts in the wake of *Feist* is readily refuted. The Register of Copyrights predicted that "*Feist* may generate new uncertainties around the application of the 1976 [Copyright] Act to databases," Ralph Oman, *Reflections on the Changing Shape of Database Protection*, 40 Fed. Bar News & J. 232, 234 (1993), and Donnelley does not even attempt to rebut BAPCO's lengthy list of commentators noting the inconsistent understandings of *Feist* in the lower courts. *See* Pet. at 27 n.15. In this case alone six of the appellate judges considering the issue after *Feist*

ruled one way, while three ruled the other way—hardly indicative of the easy and certain application of settled principles suggested by Donnelley.

Donnelley's effort to downplay the significance of the decision below is amply refuted at every turn. Donnelley itself had a very different view of the significance of this case below. Its counsel stipulated that the case involved a "question of exceptional importance in light of the increasing and vital importance of electronic means for information storage and retrieval," Statement of Counsel Pursuant to Eleventh Circuit Rule 35-6(c), at 1, and noted that "[c]orrect decision of [the issue presented] is of great importance, not only to the parties to this case but to a vast industry of publishers and database compilers whose businesses depend upon correct delineation of the delicate balance between free access to public domain information on the one hand and protection for original authorship on the other." *Id.* at 2. Donnelley further recognized that disagreement in the courts on the issues presented in this case "will create costly uncertainty and confusion in information-based industries that are increasingly central to the flow of commerce." Donnelley's Suggestion of Rehearing En Banc and Petition for Rehearing, at 7.

The amicus filings by Ameritech, NYNEX, Bell Atlantic, Sprint, and the United States Telephone Association confirm the significance of the case to the classified directory industry. By the same token, the amicus filings by West Publishing and Martindale-Hubbell confirm the broader significance of the decision below to the compilation industry generally. This significance is amplified by the fact that the compilation industry typically publishes nationwide, and is therefore particularly affected by disparate circuit rulings. In addition, although the decision is only a few months old, commentators have already noted its troubling impact.[4]

[4] *See, e.g.*, 46 Pat. Trademark & Copyright J. 421 (BNA Sept. 16, 1993) (Eleventh Circuit's "suggestion that the originality of

The divided en banc decision here is not the limited ruling Donnelley seeks to portray. The majority below ruled that this case was just like *Feist*, though it is not; that the court did not need to consider BAPCO's directory "as a whole," though the statute uses just those terms; and—despite Judge Hatchett's urgings—that it should not follow the Second Circuit's lead in *Key Publications*, which recognized that the compilation of a yellow pages directory "entailed the de minimis thought needed to withstand the originality requirement." *Key Publications*, 945 F.2d at 514.

CONCLUSION

For the foregoing reasons, and those in the Petition, this Court should grant the writ and reverse the decision below.

Respectfully submitted,

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BAPCO's business directory must be judged by comparison to other business directories raises the specter of a novelty standard for evaluating compilation copyrights"); Ira J. Blumberg, Feist *Is Expanded to Include Yellow Pages Copying*, 10 Computer Law Strategist (Oct. 1993), 1, 6 ("Apparently, any compilation that selects and organizes information in a fashion similar to other existing compilations will not merit copyright protection because it will lack originality.").